



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/671,463

09/29/2003

Hidehiko Fujiwara

Q77726

7948

23373 7590 05/28/2008  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/671,463	<b>Applicant(s)</b> FUJIWARA ET AL.	
	<b>Examiner</b> APRIL Y. SHAN	<b>Art Unit</b> 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007 and 19 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-32 is/are pending in the application.
- 4a) Of the above claim(s) 4, 12 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 13-19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 November 2007 has been entered.

2. Claims 1-7, 10-11, 13, 15-26, 28-29 and 31-32 have been amended. Claim 12 is canceled. No new claims have been added. Claims 1-11 and 13-32 are currently pending in the present application.

### ***Election/Restrictions***

3. Applicant's election without traverse of Species I (Claims 1-3, 5-11, 13-19 and 21-32) in the reply filed on 19 March 2008 is acknowledged. Since the Applicant did not indicate in the response that non-elected Species II (Claims 4 and 20) are canceled or withdrawn from consideration, the non-elected claims 4 and 20 are considered as withdrawn from consideration.

4. Claims 1-3, 5-11, 13-19 and 21-32 have been examined.

### ***Response to amendment/argument***

5. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below.

6. Any objection/rejection not repeated below is withdrawn due to Applicant's amendment.

***Information Disclosure Statement***

7. The information disclosure statement filed 3 April 2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Although the Applicant provides a pertinent portion of an English translated corresponding Japanese Office Action, it fails to include a concise explanation of the relevance of the two NPL Japanese references and the instant application. Additionally, FUJITA, Ken, et al., "Hot Spots That Can Turn a Street Corner into an Office," Telecommunications, No. 219, October 2002, pages 26-44 does not have pages 26-44 as the Applicant cited on the IDS. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claim 6**, it recites "based on the advertisements as the subject of the request", lacks of an antecedent basis.

As per **claim 19**, "The internet connection service system according to claim 1" is recited. However, claim 1 is a "an internet connection service providing method", not a system as claimed by the Applicant.

In order to further examine on the merits of the claim 1, the examiner assumes claim 19 depends on claim 17.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 15-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Takada et al., (U.S. Pub. No. 20020089931)

As per **claims 1 and 17**, Takada et al. discloses an internet connection service providing method/system, comprising:

presetting a service class, among a plurality of service classes, for a user, wherein said service class is selected by the user ("...A DS class...TS class...BE class..." – e.g. par. [0007] – [0009], "In the conventional example having the above configuration, the band monitoring part 51 is informed in advance of a transmission bandwidth (hereinafter referred to as "contracted bandwidth") that the user of the above-mentioned terminal, for example, requested at the time of contract" – e.g. par. [0012] and fig. 8);

authenticating said user, when logging in to a network, according to said preset service class for said user ("Every time receiving a packet (hereinafter referred to "new packet") from each terminal, the band monitoring part 51 performs a rate-based congestion control (mean policing) by performing the following series of operations: (1) Identifies a flow (including the identifier of a sender) to which the new packet belongs by referring to a prescribed field of the new packet. (2) Acquires a contracted bandwidth of the sender terminal. (3) Judges, according to a prescribed algorithm such as the leaky bucket algorithm, whether the rate (average rate) of packets belonging to the identified flow exceeds the contracted bandwidth.." – e.g. par. [0012] – [0015] and fig. 9);

recognizing said preset service class for said user and providing a service, corresponding to the recognized service class, to said user ("As shown in FIG. 9, a sequence of packets that are sent from a terminal accommodated in the local station (or packets received from a preceding transmission section) is supplied to the input of a band monitoring part 51.

The output of the band monitoring part 51 is directly connected to the input of a congestion controlling part 52. The congestion controlling part 52 has outputs corresponding to respective service classes (for simplicity, it is assumed here that they are the above-described DS (delay sensitive) type, TS (throughput sensitive) type, and BE (best effort) type service classes) to which the packets may belong. The outputs of the congestion controlling part 52 are directly connected to the inputs of queues 53-1 to 53-3 that correspond to the respective service classes. The outputs of the queues 53-1 to 53-3 are connected to respective ports of a packet switch (not shown; or a line interfacing part). The control terminals of a scheduler 54 that plays a leading role in reading (first-in first-out) of the queues 53-1 to 53-3 are directly connected to the read control terminals of the queues 53-1 to 53-3,

respectively... Passes the new packet to the congestion controlling part 52 when the judgment result is false.” – e.g. par. [0011] – [0017]).

As per **claim 15**, Takada et al. discloses a method as applied above in claim 1. Takada et al. further discloses wherein said provided service is classified by predetermined communication qualities (e.g. fig. 8 and par. [0004] – [0009]).

As per **claim 16**, Takada et al. discloses a method as applied above in claim 1. Takada et al. further discloses wherein said provided service is classified based on a kind of preset accessible media and protocol (e.g. fig. 8 and par. [0004] – [0009]).

As per **claims 3 and 19**, Takada et al. discloses a method/system as applied above in claims 1 and 17. Takada et al. further discloses wherein said service class is preset for said user on the basis of a contract (e.g. par. [0012]).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) in view of De Cnodder et al. (U.S. Pub. No. 20030048791).

As per **claims 2 and 18**, Takada et al. discloses a method/system as applied above in claims 1 and 17. Takada et al. further implicitly discloses wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user by disclosing contracted bandwidth at the of contract (e.g. par. [0012]).

Takada et al. does not expressly disclose wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user.

However, De Cnodder et al. discloses wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user ("...supports a plurality of service classes, such that Internet Service Providers can implement a pricing strategy which respect to the plurality of service classes...at a high cost...at an average cost...at a low cost..." – e.g. par. [0001], [0004] and [0005]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate De Cnodder et al.'s wherein a fee corresponding to the service class is computed



Art Unit: 2135

based on fee managing data and charged to said user into Takada et al. motivated by "the Internet Service Providers (ISPs) can differentiate their services, and implement different pricing strategies, such that a better class of service will cost the end user more money" (De Cnodder et al. par. [0005])

16. Claims 5-7, 21-23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) in view of Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office).

As per **claims 5 and 21**, Takada et al. does not expressly disclose wherein advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class.

However, this well known feature of advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class is disclosed in Jun (e.g. par. [0030] – [0032]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Jun's advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class into Takada et al. motivated by increasing an opportunity to supply the advertisement of own goods to a customer according to a demand of a customer (Jun, par. [0030] and [0032])

As per **claim 6**, Jun further discloses wherein utilization or communication service fees concerning the distribution of the advertisement data to said user is covered by advertisement fee

paid by the advertisement requester to the ISP based on advertisements as the subject of the request (e.g. paragraph [0031]).

As per **claim 7**, Jun further discloses wherein the advertisement data preliminarily received from the advertisement requester and accumulated are further distributed to said based on advertisement distribution requests therefrom (e.g. paragraph [0050], [0055]).

As per **claims 22-23**, Jun further discloses comprises an advertisement distributing server for accumulating advertisement data preliminarily received from advertisement requester and distributing the accumulated advertisement data to said user (e.g. paragraph [0050]), the advertisement distributing server being applicable to distribute advertisement data to said user corresponding to said service class data (e.g. paragraph [0050]), wherein the service server is arranged such as not to charge any fee for advertisement distribution and communication services required therefor to said user (e.g. abstract and paragraph [0050]), wherein the service server includes a service class correspondence table for managing the plurality of service classes such as to fit advertisement distribution requests each from said user and a fee managing table for managing fees for said user (e.g. paragraph [0031] and [0050]), and distributes advertisement data received from an advertisement requester and accumulated to said user based on the service class correspondence table to meet said user's advertisement distribution requests (e.g. paragraph [0050]).

As per **claim 32**, Takada - Jun discloses a system as applied above in claim 21. Takada - Jun further discloses comprises an access control unit for limiting communication media according to preset sections provided for said user's service class, and the service server includes a media managing table, in which an accessible media and a protocol are defined for each service class (e.g. paragraph [0028] of Jun and fig. 8, par [0004] – [0009] of Takada).

17. Claims 8-10, 13-14 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) - Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office) as applied above in claim 7, further in view of Hou (Japanese 2001-111727A. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office).

As per **claim 8**, Takada et al. – Jun does not expressly disclose wherein an amount obtained by subtracting an advertisement reading fee corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged.

However, Hou discloses wherein an amount obtained by subtracting an advertisement reading fee corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged ("Especially this invention relates to the portable telephone-rates discount method and equipment using the Internet about the method of charge discount service offer of the telephone (for example, cellular-phone or PHS phone) charge for mobile communications for internet advertising activation" – e.g. par. [0001], "if people with a radio mobile phone machine like a cellular phone access the Internet with various means and visit an internet advertising site It is related with the method and equipment which connect a portable telephone with the Internet and provide an advertisement and charge discount service by the method which the mark equivalent to the number of times and time which it visited are accumulated, and can receive the benefit of portable telephone-rates discount later" – e.g. par. [0002]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Hou's wherein an amount obtained by subtracting an advertisement reading fee

corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged into Takada et al. – Jun motivated by “aims at offering the portable telephone-rates discount method and equipment with which useful information is also obtained at the same time the use charge of a portable telephone is reducible to the user of the Internet” (Hou, par. [0010]).

As per **claim 9**, Hou further discloses wherein the number of times of advertisement reading as the basis of discount computation or a value obtained by multiplying the number by a coefficient or a numerical value corresponding to frequency or degree is accumulated and updated as points (e.g. par. [0001] – [0002])

As per **claim 10**, Hou further discloses wherein the points are as well accumulated and updated with respect to said user, who has read advertisements accumulated in ISP managing a system for counting the points from the outside via the internet (e.g. par. [0011] and claim 1)

As per **claims 13-14**, Hou further discloses wherein a status indicating that said user has read advertisements by accessing a system, via the internet, and a distribution history such as the number of times and frequency of the distribution is accumulated and updated for each advertisement of advertisement data and the system is managed by an advertisement management dealer accumulating and processing advertisement data concerning advertisements requested by an advertisement requester, processes distribution record data obtained by recording the number of times and degree of advertisement distribution for obtaining a fee corresponding to the number of times and frequency of the advertisement distribution from the advertisement requester (e.g. par. [0011] and [0033]).

As per **claims 24-26**, they are rejected using the same rationale as for the rejection of claims 8-10.

As per **claim 27**, it is rejected using the same rationale as for the rejection of claim 13.

As per **claim 28**, it is rejected using the same rationale as for the rejection of claim 14.

As per **claims 29-30**, they are rejected using the same rationale as for the rejections of claims 13-14.

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) as applied above in claim 1 and further in view of Hou (Japanese 2001-111727A. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office).

Takada et al. does not expressly disclose wherein advertisement data preliminarily received from the advertisement requester and accumulated are distributed to said user, and a distribution history, such as the number of times and degree of the distribution, is accumulated and updated for each advertisement of the advertisement data.

However, this well known feature of wherein advertisement data preliminarily received from the advertisement requester and accumulated are distributed to said user, and a distribution history, such as the number of times and degree of the distribution, is accumulated and updated for each advertisement of the advertisement data is disclosed in Hou (e.g. par. [0001] – [0002] and par. [0033]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Hou's wherein advertisement data preliminarily received from the advertisement

requester and accumulated are distributed to said user, and a distribution history, such as the number of times and degree of the distribution, is accumulated and updated for each advertisement of the advertisement data into Takada et al. motivated by "aims at offering the portable telephone-rates discount method and equipment with which useful information is also obtained at the same time the use charge of a portable telephone is reducible to the user of the Internet" (Hou, par. [0010]).

19. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) in view of Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018 as applied above in claim 21, and further in view of Applicant's admitted prior art by Kawano (Japanese Patent Laid-open 2001-298484. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office)

As per **claim 31**, Takada - Jun discloses a system as applied above in claim 21.

Takada - Jun does not disclose expressly comprises a QoS (quality of service) unit for controlling a preset QoS for said user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset.

Kawano discloses comprises a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset (e.g. abstract, paragraph [0015] and [0039]-[0040]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset to Takada - Jun's system. The motivation of doing so

would have been for a user “to choose freely the service conditions of a network service to use at every connection and can specify them when connecting with a network from a user terminal and has the effectiveness of becoming possible to offer the network service according to the service condition”, as taught by Kawano (paragraph [0039]).

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO – 892). In particular, references JP 2002135427, WO 0223423, JP 2000295216 and JP 2001298484. Applicant is **strongly urged** to review these references in response to the current office action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/  
Examiner, Art Unit 2135

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135



Application/Control Number: 10/671,463  
Art Unit: 2135

Page 16